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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,324	02/07/2002	Mutsumi Harada	X2007.0002/P002	4579

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EXAMINER

DUONG, THANH P

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,324

Applicant(s)

HARADA ET AL.

Examiner

Tom P. Duong

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/11/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicants' remarks and amendments filed on April 8, 2005 have been carefully considered. Claims 1 and 2 have been amended. Claims 8-12 have been withdrawn. Claims 1-18 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1-7 and 13-18 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobayashi (6,558,273).

Note, the metal golf club head is being examined as an apparatus. Regarding claims 1-2 and 13-18, Kobayashi discloses a metal golf club head (Fig. 2), comprising: a ball hitting face (16) made of a metal (Col. 4, lines 20-21), which includes a central portion (as shown on Fig. 2) and a peripheral portion surrounding at least a part of said central portion (as shown on Fig. 2). With respect to the hardness of the metal at said peripheral portion is lower than the hardness of the metal at said central portion, Kobayashi discloses the face member is subject to direct aging treatment to improve surface hardness (Col. 6, lines 11-14) and further discloses the outer periphery of the face member is welded to the body member 17 after heat treatment. Note, it is known in the golf club art that the surface hardness is reduced in the affected welding zone

area (See USPN 6,280,349 and USPN 5,275,409). In light of applicants' specification (page 8, lines 5-15), it is inherent and/or obvious in view of Kobayashi to one having ordinary skill in the art that the face member of Kobayashi has a higher surface hardness in the central portion than its periphery portion being the fact that the periphery portion are subjected to the affected welding area, which has a lower surface hardness than the central portion (unwelded surface area). With respect to the face member subjected to a heat treatment process such as aging treatment prior to a welding process, it is conventional to provide heat treatment to the face member prior to welding the club parts together (see USPN 6,079,612). In addition, there is no distinctive structural characteristics to the final product of the golf club head whether the face member is subject to heat treatment prior to welding versus welding club parts prior to heat treatment. See *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979). Regarding claims 3 and 4, Kobayashi does not disclose the method of determining the hardness difference between the central portion and its periphery portion; however, it is inherent and/or obvious in view of Kobayashi to one having ordinary skill in the art that the face member of Kobayashi has a hardness difference between the central portion and its periphery portion as described above. Note, the method of "measuring" and "determining" the face hardness does not further limit the structure of the claimed invention in an apparatus claim. With respect to claims 5-7, Kobayashi does not disclose the difference in the hardness between said central portion and periphery portion is equal to or greater than 50 in terms of the Vickers hardness. However, Kobayashi discloses the face material with heat treatment and welding

technique of the claimed invention; thus, it is inherent and/or obvious in view of Kobayashi to one having ordinary skill in the art that the face member of Kobayashi exhibits the hardness characteristics of the claimed invention. Note, the method of "measuring" and "determining" the face hardness does not further limit the structure of the claimed invention in an apparatus claim. Note, when the claimed and prior art products are identical or substantially identical in structure or composition, or produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 255, 195 USPQ 430, 433 (CCPA 1977). See MPEP 2112.01.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,280,349 and USPN 5,275,409 disclose the hardness of the material is reduced in the affected welding zone. USPN 6,079,612 discloses conventional method of heat treatment to the face member prior to welding the club parts together.

Response to Arguments

Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive. With respect to argument of aging treatment prior to the welding process, the cited reference of USPN 6,079,612 discloses conventional method of heat treatment to the face member prior to welding the club parts together. In addition, the heat treatment prior to welding process does not impart distinctive structural

characteristics to the final product of the club head. See MPEP 2113 Product-by-Process Claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P. Duong whose telephone number is (571) 272-2794. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Duong
June 21, 2005
TD

Tb



Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700